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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DONAGHUE, LARRY D

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/737,477

Applicant(s)

LAI ET AL.

Examiner

Larry D Donaghue

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2004.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,8 and 9 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,3-5,8 and 9 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Art Unit: 2154

1. Claims 1, 3-5 and 8-9 are presented for examination.
2. Claims 1, 3-5, and 8-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Finding and **activating** the software (last clause in claim 1) is not disclosed in the specification in any manner as the element of activating the software is not defined in the context of the software being proceed in any manner in the specification.
3. Claim 1 is objected to for lacking proper antecedent basis in the specification for the element **activating** the software.
4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-5 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Making Email Talk With MIME, The UIC Academic Computing Center, www.uic.edu/deptslacc/newsletter/adnl3/mime.html, pp. 1-12, October 1996, hereinafter "UIC Reference."
6. The UIC reference discloses the invention substantially as claimed including a method comprising: Storing at least one predetermined keyword in a first electronic device in advance, the keyword being related to one of a plurality of software installed in said first electronic device (pp. 1-12, particularly pp. 9-10 configuring MIME types in Netscape - with Content-Type as a predetermined keyword, the combination being related to a particular application - e.g., Word Perfect); Appending a keyword in an electronic message sent from a remote second electronic device to the first electronic device (pp. 1-12, particularly pp. 3-4 s); Searching the predetermined keyword by a first microprocessor of the first electronic device after the electronic message is received (pp. 1-12, particularly); Finding the predetermined keyword matched to the keyword contained in the electronic message (pp. 1-12, particularly); Finding the software related to the predetermined keyword if there is a match between the predetermined keyword and the keyword contained in the electronic message (pp. 1-12, particularly p. 3 How You Do MIME showing automatic display of attachment and pp.); Processing the electronic message by the related software (pp. 1-2, particularly p. 3 How You Do MIME showing automatic display; pp. 8-10 showing automatic display/processing by Word Perfect of a received Word Perfect file).
7. The UIC Reference does not specifically teach a method wherein each of the electronic devices is a mobile phone. Official notice is hereby taken of the facts that: (a) the use of mobile phones to receive email is known in the art and (b) mobile phones comply with Internet standards for receiving email. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the UIC Reference's sender and receiver

Art Unit: 2154

computers to be mobile phones compliant with Internet standards for sending and receiving email. This modification would have been obvious because it would allow the user to send and receive email anywhere.

8. Regarding claim 3, the UIC Reference teaches a method wherein the electronic message is processed by a typical receiving process when there is no keyword found in the electronic message (pp. 1-12 email without MIME content-type is received).

9. Regarding claim 4, the UIC Reference teaches a method wherein when no electronic message is received as determined by the microprocessor, the microprocessor performs the steps of determining whether there is a sent electronic message and ending the process if the determination is negative (pp. 1-12 implicit that a user agent sends no email message if none is pending); reading the attached keyword contained in the electronic message if the determination is positive (pp. 3-4 Sending a File); appending the attached keyword to the electronic message (p. 5 Sample MIME Message showing Content-Type in message); sending the electronic message to the remote second electronic device (pp. 3-4 Sending a File); and ending the process after sending (pp. 1-12 implicit that a user agent ends the process as defined by the claimed method steps after sending).

10. Regarding claim 5, the UIC Reference teaches a method wherein the electronic message is processed by the microprocessor by a typical sending process when no attached keyword is found in the electronic message as determined by the microprocessor (pp. 1-12)

11. Regarding claim 8, the UIC Reference teaches a receiving process wherein the electronic message is an e-mail (pp. 1-12).

12. Regarding claim 9, the UIC Reference teaches a receiving process wherein the electronic message is a short message (p. 2 What MIME Does - email messages as short messages).

13. Applicant's arguments filed 08/17/2004 have been fully considered but they are not persuasive.

14. Applicant argues the UIC reference fails to teach finding and directly activating electronic processor software after a simple keyword search of the message, as opposed to determining a data type upon opening the message and processing the header, and only then activating software related to the data type; and (ii) a mobile phone with the capability of finding and activating electronic processor software related to keyword.

15. In Response, the argument (i) are not commensurate in scope with claim language, the claim language is open ended, nor does the specification expressly support this position. As to position (ii), see rejection of claim 1.

16. Applicant argues The claimed invention provides a shortcut suitable for use in mobile phones.

In response, See rejection of claim 1.

17. Applicant argues "in the claimed invention, it is the keyword search and not processing of a MIME header by a MIME agent that activates the specific software used to process the message. As a result, it is respectfully submitted that the claimed "keyword" is not the same as the "content type" extension or any other information contained in the MIME header described in the UIC reference."

18. In Response, the argument are not commensurate in scope with claim language, the claim language is open ended, nor does the specification expressly support this position.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2154

Deen et al.	6,629,127
Goetz et al.	5,956,729
Luzeski et al.	6,430,177

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry D Donaghue whose telephone number is 571-272-3962. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


LARRY D. DONAGHUE
PRIMARY EXAMINER

Application/Control Number: 09/737,477

Page 5

Art Unit: 2154